THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MARVIN L. WILLIAMS

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Appeal No. 96-3056
Application 08/173,287[1]

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ON BRIEF

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Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-16, which constitute all the claims in the application.

[1] Application for patent filed December 21, 1993.

The disclosed invention pertains to a method and apparatus for selectively capturing information from a multimedia presentation within a data processing system, and designating a calendar event to be associated with the captured information.

Representative claim 1 is reproduced as follows:

1. A method, performed in a data processing system, for selectively capturing information from a multimedia presentation within a data processing system, said data processing system including a calendar, said method comprising the computer implemented steps of:

selecting information from a multimedia presentation within the data processing system;

designating a calendar event of a calendar within the data processing system; and

associating said selected information to the designated calendar event within the data processing system.

The examiner relies on the following reference:

Baber et al. (Baber)	5,323,314	June 21, 1994 (filed Dec. 31, 1991)

Claims 1-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Baber.

Rather than repeat the arguments of appellant or the

examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Baber does not fully meet the invention as recited in claims 1-16. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will stand or fall together in the following three groups: Group I has claims 1, 5-8 and 12-14, Group II has claims 2-4 and 9-11, and Group III has claims 15 and 16

[brief, page 3]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims within each group. Although the examiner asserts that appellant's arguments are not sufficient to warrant separate patentability of the groups, we find appellant's arguments on pages 8-10 of the brief to
adequately support the request to have the groups of claims

considered separately for patentability within the requirements of 37 CFR § 1.192.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 8, the

examiner has indicated how he reads these claims on the disclosure of Baber [answer, page 3]. Appellant argues that Baber does not disclose the step of associating the selected information to the designated calendar event. Appellant also argues that Baber does not disclose the step of selecting information from a multimedia presentation. Finally, appellant argues that Baber does not designate a calendar event, but rather, creates a calendar event. The examiner disagrees with each of appellant's arguments and argues that appellant is interpreting the scope of the claimed invention too narrowly.

We agree with the examiner that Baber discloses selecting
information from a multimedia presentation [column 11, lines 4-8], and that in order to create a calendar event Baber must first broadly designate a calendar event (such as date in Baber's Figures 2a and 2b). We do not agree with the examiner, however, that the step or means of "associating said selected information to the designated calendar event within the data processing system" is disclosed by Baber.

On this point appellant argues that the information

selected in Baber is associated with a desired attendee, meeting site and/or element of equipment rather than being associated with the designated calendar event [brief, pages 5-6]. The examiner responds with the following position:

> [I]t is clear that all the information in the database and the display of Baber et al. is associated with all of the other information. The term "associated with" has no particular meaning in the art, and as such, Examiner has given a logical, reasonable, broad interpretation to the term [answer, page 7].

Although we agree with the examiner that claim language should be given its broadest reasonable interpretation during the course of prosecution, we do not agree that the associating step of claims 1 and 8 can be interpreted as broadly as the examiner has interpreted it. The idea that all information in a computer is "associated with" all other information in the computer is not reasonable. The step of associating one piece of information with (to) another piece of information suggests that there is some logical relationship or nexus between the two pieces of information. We agree with appellant that the data selected

in Baber, such as the display of subwindow 76, is associated with the attendee, the meeting site and/or an element of equipment rather than with the designated calendar event such as date. In other words, any information selected in Baber brings up a window that associates that information with further information, but it does not associate the selected information with a designated calendar event.

In summary, even though the scope of the invention as recited in independent claims 1 and 8 is relatively broad, the examiner's broad interpretation of the associating step is inconsistent with the logical meaning of that step and is not disclosed within Baber in a manner necessary to support a rejection under 35 U.S.C. § 102. Therefore, we do not sustain the rejection of independent claims 1 and 8 as anticipated by the disclosure of Baber. Since the remaining claims depend from

either claim 1 or claim 8, we also do not sustain the rejection of any of these claims as anticipated by the disclosure of Baber.

The decision of the examiner rejecting claims 1-16 is

reversed.

REVERSED

Jerry Smith Administrative Patent Judge	)	
Joseph F. Ruggiero Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Anita Pellman Gross Administrative Patent Judge	)	

dm

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